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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/299,539	04/26/99	MUNOZ-ESCALONA LAFUENTE A	B-3643-61707

IM22/0320

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EXAMINER	
PASTERCZYK, J	
ART UNIT	**PAPER NUMBER**
1755	14

DATE MAILED: 03/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/299,539	Applicant(s) Lafuente et al.
	Examiner J. Pasterczyk	Group Art Unit 1755

☒ Responsive to communication(s) filed on *Mar 12, 2001*.

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-8 and 10-21* is/are pending in the application.

Of the above, claim(s) *8 and 20* is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-7, 10-19, and 21* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims *1-8 and 10-21* are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *12*

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. This Office action is in response to the faxed supplemental amendment and IDS filed 3/12/01 and refers to the rejection mailed 3/12/01.

2. Initially, the examiner notes that the claims in this case are 1-8 and 10-21, that claims 1 and 21 are the only independent claims, with claims 2-6, 8, 10, 11 and 20 depending from claim 1, claims 16 and 19 depending from claim 3, claim 7 depending from claim 6, claims 12, 13, 15 and 18 depending from claim 2, and claims 14 and 17 depending from claim 12. Claims 8 and 20 are withdrawn from consideration due to a previous restriction requirement. In the previous amendment, applicants attempted to renumber claims which had already been renumbered by the clerks of the PTO according to Rule 126; this they cannot do simply by requesting in amendment that claims be renumbered. When there is a break in the serial numbering of claims as filed by an applicant, the PTO clerks automatically renumber the claims serially according to Rule 126. Hence originally filed claims 1-4 remain so numbered, originally filed claims 6-10 were renumbered as 5-9, and added claims 11-21 were renumbered 10-20, with claim 9 now cancelled and claim 21 now added. The numbers of the claims given at the beginning of this paragraph reflect the correct renumbering, which applicants should adhere to henceforth.

3. The abstract of the disclosure is objected to because it is now far too broad and vague, lacking the apparent invention, i.e. the presence of siloxane groups on side groups of the metallocenes which react with the surface-bound alumoxane or surface-bound hydroxide groups to form a covalent bond between the metallocene and the support or alumoxane. Correction is required. See MPEP § 608.01(b).

4. Claims 1-7 and 10-19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment of 1/23/01 changing the formulae for II and III does not appear to have any support in the specification as originally filed. The formulae given at p. 6 et seq. of the specification do not conform to these general formula, hence no support is found for these formulae at all.

5. Claims 1-7, 10-19 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 21, it appears necessary that the porous inorganic support material have surface hydroxyl groups which may react with the siloxane groups necessarily present in the metallocene compounds or the alkyl groups necessarily present on the alumoxanes so that a covalent bond may be formed between the support and the catalyst or cocatalyst; lack of such amounts to an "invitation to experiment"; *In re Gardner, Roe and Willey*, 166 USPQ 138 (CCPA 1970). Otherwise, it is not clear how the metallocene or alumoxane remains bound to the surface of the support material, since surface bridging Si-O-Si units would not likely react with the siloxane groups of the metallocene or the alkyl groups of the alumoxane.

Further in claim 21, if m is only 1, then the text reciting this should be deleted as prolix and the variable also deleted from the formulae.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-7, 10-19 and 21 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hidalgo Llinas as cited in and for the reasons of record given in paragraph 9 of the previous Office action.

8. Claims 1-7, 10-19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Antberg in view of Welborn as cited in and for the reasons of record given in paragraph 10 of the previous Office action.

9. Applicant's arguments filed 1/23/01 have been fully considered but they are not persuasive.

Applicants first apparently believe that the rejection over Hidalgo Llinas is a straight obviousness rejection rather than an inherency rejection, which is what is made when a 102/103 rejection is invoked. Hence the appeal to a *Graham v. John Deere* type of analysis is unavailing, since the proper way to defeat an inherency rejection is by a showing under rule 132 that the product claimed is in fact different from that disclosed in the prior art under *In re Best*, 195 USPQ 430, 433 (CCPA 1977). Since Hidalgo Llinas also contains metallocenes having groups which would react analogously to the $-R^{I}OSiR^{II}_{3}$ group, it would logically react in the same manner with the residual surface hydroxyl groups of the porous inorganic support as the product-by-process claims of the present invention.

Regarding the argument against the 103 rejection made using Antberg in view of Welborn, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). However, here the reasoning for combining the references was found directly from the references themselves rather than via any sort of hindsight. In addition, Antberg also contains metallocenes which would react analogously to the $-R^{I}OSiR^{II}_{3}$ group, thus they would logically react in the same manner with the residual surface hydroxyl groups of the porous inorganic support as the product-by-process claims of the present invention.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Pasterczyk whose telephone number is (703) 308-3497. Our fax number is 305-5433.

Mark L. Bell
Supervisory Patent Examiner
Technology Center 1700

J. Pasterczyk

March 15, 2001